

1. This paper is a replacement for an Office Action mailed on 2/18/2009 – it is also the answer for a response received on 10/07/2008.
2. Claims 1-40 are pending in this application, wherein claims 1-14 were withdrawn – in this Office Action, further election is required base on the pending claims’ language.

*Response*

3. In a claims 15, is directed to a system for controlling speeds of a turbine engine (i.e., this broad subject matter is not necessary related to a claimed subject matter of “a rail vehicle” as amended in claim 16).

Since different search strategies must be done to completely cover all claimed subject matters (for a method of controlling a speed of a turbine engine comprising steps, for a rail vehicle, and for a general system having physical components for controlling a speed of a turbine engine – e.g., in a power plant) the examiner submits that restrictions are proper.

The examiner is regret for any delay this may cause.

*Claim Rejections - 35 USC 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 15 is rejected on 35 USC 112, 2<sup>nd</sup> para. based on lacking an antecedent basis for “the power requirement” in claim 15, line 4, since a power requirement is not defined in this claim yet.

“Independent” claims 16, and 33 are rejected on 35 USC 112, 2<sup>nd</sup> para. since there is no limitation including in these claims’ bodies (limitation(s) must be explicitly required for each claim – these claims are independent because they are clearly directed to “a rail vehicle”).

Claim 20 is rejected on 35 USC 112, 2<sup>nd</sup> para. based on lacking an antecedent basis for “to measure the speed of the electric motor” in claim 20, line 2, since a speed is not defined yet.

As to “system” claim 19 line 2, and claim 25 line 2, and claim 34 line 5, a statements of intended use or field of use, i.e., "being capable to" clause provides language that suggests or makes optional but does not require steps to be performed or does not limit the scope of a claim or claim limitation (see MPEP § 2106 II C). Accordingly, the metes and bound of the claim can not be ascertained by one having ordinary skill in the art – they are rejected on 35 USC 112, 2<sup>nd</sup> para..

System” claims 24, 26-32, 37, 39-40 have unclear limitations – a structural limitation to further limit “a controller unit”/”said controller unit” (from its parent claim) is not found in these claims – they are rejected on 35 USC 112, 2<sup>nd</sup> para.

*Election/Restriction*

5. Restriction to one of the following inventions is also required under 35 U.S.C. § 121 in addition to method claims:

I. Claims 16, and 33-37, are drawn to physical and structural systems for controlling speeds of a turbine engine powering “a rail vehicle”, (claimed language explicitly show that claims 16, and 33, are drawn to a rail vehicle having a turbine engine), classified in US class 701, subclasses 19- 20.

II. Claims 15, 17-32, and 38-40 are drawn to a physical and structural system (for controlling speeds of a turbine engine having a primary electric load) - (not necessary related to a subject matter of “a rail vehicle”, – e.g., in a power plant), classified in US class 60/239.

6. The inventions are distinct, each from the other because of the following reasons:

Group I and group II separately disclose different species (as shown by pending claimed language), they are distinct (for different fields of applications) and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143)

Applicants are required under 35 U.S.C. 121 to elect a specific group for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable – according to the pending claimed language, no generic claim is seen to be patentable.

Further, “system” claims 27 and 28 are belonged to claim 26; however, they split into two different species:

As to claim 27: its limitations do not include speed requirement of a turbine engine.

As to claim 28: its limitations do concern about a speed requirement of a turbine engine.

Further, “system” claims 39 and 40 are belonged to claim 26; however, they split into two different species:

As to claim 39: requires that “...secondary electric loads remains substantially constant”.

As to claim 40: requires that “...secondary electric loads remains within a predetermined tolerance range”.

An election is required for claim 27/28, and an election is required for claim 39/40.

All these claims would be rejoined after their parent claims are allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

/CUONG H. NGUYEN/  
Primary Examiner  
Art Unit 3661